

II. Remarks

By this paper, Applicant is amending claims 1, 10 (withdrawn), 19, and 23 (withdrawn), and is adding claims 31-36. Therefore, after entering this amendment, claims 1, 3-6, 9, 19, 22, 29, and 30-36 are currently pending.

No new matter is added by any amendment herein. Reconsideration and further examination of this application in view of the above amendments and the following remarks is therefore respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Citing, 35 U.S.C. § 102(b) the Office Action rejected claims 1, 3-5, 19, and 29-30 as being anticipated by Morrison (US4748986), claims 1, 3-6, 19, and 29 as being anticipated by Miyata (US5910364), and claims 1, 3-6, 9, 19, 22, and 29-30 as being anticipated by Tezuka (US6251085).

Each of the independent claims has been amended to clarify that the claimed device includes an open lumen. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (from MPEP § 2131). Each of Morrison, Miyata, and Tezuka fails to disclose wire coils wound adjacent to one another defining an open lumen. Specifically, the wound wire shafts of Miyata and Tezuka are both generally solid with no lumen, and the wound wire shaft of Morrison is not open in that it requires an elongate core element (e.g., elongate elements 12, 32, which – although they may be cylindrical, nonetheless occlude/occupy the space around which coils 13, 33 are formed without leaving an open lumen such as is disclosed in the present application at, for example, ¶¶[0018], [0050], [0073], and FIGS. 2, 8, and 28-32). Therefore, none of the independent claims are anticipated by any of Morrison, Miyata, or Tezuka.

Additionally, Tezuka fails to disclose a body portion having a multiple filament group of individual wire coils wound adjacent to one another, as recited in claims 1 and 19. For example, Tezuka discloses an inner core 12 made of three wires stranded, or twisted, together. (Tezuka, col. 6, lines 46-51). Moreover, Tezuka distinguishes

between coiled wires and stranded, or twisted, wires by stating, "inner core 12 is formed of a strand without a core member, the transmission ability, which is required during operation, when the guidewire 11 is twisted is more excellent than in the case in which the coiled wire is used for the inner core." (Tezuka, col. 7, lines 1-6). Furthermore, *Tezuka* fails to disclose a body portion having a first diameter, a distal end portion having a substantially constant second diameter less than the first diameter, and a taper portion between the first and second diameters, as recited in claim 1. For example, *Tezuka* discloses a twisted inner core 12 having an ever-decreasing outer diameter, but fails to disclose a substantially constant second diameter and a tapered portion between the first and second diameter portions. (*Tezuka*, col. 4, lines 54-58). Therefore, for this separate and distinct reason, claim 1 is not anticipated by *Tezuka*.

Each of the independent claims is distinguished from the art of record. Therefore, each of the pending dependent claims are allowable for at least the reasons discussed above. Accordingly, Applicant respectfully requests that the rejection be withdrawn and these claims recognized as being in condition for allowance (including rejoinder of the withdrawn claims, which include all of the same limitations).

New claims 31-36 recite an elongate medical device with the same wound wire construction and open lumen, and are allowable for the same reasons as the other claims. The presently-claimed device is constructed in a manner configured to function as a guidewire, a guidewire-directed catheter, and/or a "guidewire-less catheter" as described, for example at Example 2 (¶[0093]), and at ¶¶[0016], [0059], [0064]-[0065], [0073], [0081], and [0102], and it is claimed accordingly.

Conclusion

In view of the above amendments and remarks, it is respectfully submitted that the present claims are patentably distinguishable over the art of record and that this application is now in condition for allowance, including rejoinder of the withdrawn claims. The Examiner is invited to contact the undersigned attorney for the Applicant via telephone number (312) 222-8104, if such communication would expedite this application.

Respectfully submitted,

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